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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,045	08/03/1999	GREGORY MCDONALD	CITI0110	5055

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EXAMINER

KYLE, CHARLES R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/368,045

**Applicant(s)**

MCDONALD ET AL.

**Examiner**

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,13-16,18,20,22,23,30,31,33-36,44-48,51,55-79 and 82-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,13-16,18,20,22,23,30,31,33-36,44-48,51,55-79 and 82-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 13-16, 18, 20, 22, 23, 30, 31, 33-36, 44-48, 51 and 55-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Transue et al in view of Lawlor et al and further in view of Porter et al.

Concerning Claim 1, Transue et al disclose the invention substantially as claimed including in a method of bill payment service for a customer:

receiving identification information for the customer by a retail system application in response to an automatic prompt of the customer by the retail system application (col. 2, lines 22-36);

automatically verifying the identification information by the retail system application (col. 2, lines 22-36) and handing off the customer and the identification information to a bill payment application (col. 15, line 63 to col. 16, line 10);

receiving a customer selection of one of a touch tone mode and a voice mode of communication in response to an automatic prompt by the bill payment application (col. 3, line 66 to col. 4, line 40);

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receiving a customer selection of a bill payment option from a group of bill payment options consisting of a recurring bill payment option (Fig. 4, element 402), an add or change payee for bill payment option (Fig. 3A, elements 316 and 328), a single bill payment option (Fig. 4, element 402), and a status, change or cancel bill payment option (Fig. 5, element 500), in response to an automatic prompt by the bill payment application;

receiving a customer selection of an option to designate the payee by one of entering a payee ID by the customer from the customer-specific payee identification list and selecting the payee from the customer-specific payee identification list spoken by the bill payment application, if the option to designate the payee from the customer-specific payee identification list is received;

receiving information about a payment amount for at least one bill payment for the customer by the bill payment application in response to an automatic prompt by the bill payment application;

receiving information about a payment date for the bill payment by the bill payment application in response to an automatic prompt by the bill payment application (col. 12, lines 6-9);

automatically scheduling the bill payment by the bill payment application

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for the customer according to the bill payment information (col. 11, lines 54-61);

receiving a confirmation of the payee, the payment amount, and the payment date for the scheduled bill payment by the bill payment application in response to an automatic prompt by the bill payment application (col. 11, lines 50-58, col. 12, lines 1-5 and col. 12, lines 13-18 and col. 11, lines 54-61).

Transue et al do not specifically disclose receiving a customer selection of an option to designate a payee from one of a customer-specific payee identification list of the customer and a common payee list provided by the bill payment application, in response to an automatic prompt by the bill payment application. Lawlor et al disclose a common pre-selected list at Col. 10, lines 44-53 and a customer-specific payee identification list at Col. 33, lines 3-22. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the pre-selected list taught by Lawlor in the invention of Transue et al because this would have allowed payors to use the system who had neither time nor patience to prepare a customer-selected list. Further, it would have been obvious to have provided the payor an alternative unique list which would have been a timesaving feature for frequent users of the system.

Transue et al do not specifically disclose rendering the scheduled bill payment to the payee by the bill payment application for the customer by one of a check and an electronic transfer of funds to the designated payee on the payment date indicated by the customer. Lawlor et al disclose these features at col. 43, line 48 to col. 45, line 48 and col. 11, lines 55-60 and col. 33, line 63 to col. 34, line 1. See also Col. 7, lines 5-24. It would have been obvious to one of

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ordinary skill in the art at the time of the invention to have provided the alternative payment modes disclosed by Lawlor et al in the invention of Transue et al because this would have given payors a convenient choice of well recognized payments methods to complete payment of bills.

Transue et al and Lawlor et al do not specifically disclose automatically, non-optionally handing off the customer to a customer service representative by the bill payment application for a non-automated verification of the customer's identification by the customer service representative at a telephone as a security measure, if the customer selection is received for one of the recurring bill payment option and the add or change payee for bill payment option. Porter discloses elements of automatically, non-optionally handing off the customer to a customer service representative by the bill payment application for a non-automated verification of the customer's identification by the customer service representative at a telephone as a security measure (Fig. 3B, eles. 234, 235, 226 and related text; Col. 9, lines 34-45) and customer selection for one of the recurring bill payment option and the add or change payee for bill payment option (Fig. 14, eles. 638, 640, 641; Figs. 15A and 15B). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided automatic identification in the processing of recurring bill payment option and the add or change payee for bill payment option as taught by Porter in Transue and Lawlor because this would have prevented misuse of the bill payment invention by unscrupulous persons who might wish to divert payments from a payor's account to their own accounts. Lawlor particularly discloses a concern with security of transactions at the Background and Summary of the Invention and this security would have been enhanced by automatic review by a human operator. Particularly see Lawlor at Figs. 9 and 10 which address use of a secure PIN to access bill-paying functions.

Regarding Claim 13-16, Transue et al disclose selection of one of a touch tone mode and a voice mode of communication for entering bill payment information for the customer at col. 3, line 66 to col. 4, line 40. They also disclose receiving bill payment information at Col. 3, lines 15-40. They also disclose an automatic prompt of the customer by the bill payment application for the selection of a mode at Fig 1., "Press 1 or Say" item.

Concerning Claim 18, Transue et al disclose receiving an election for a recurring bill payment option at Fig. 4, right hand side of figure and col. 11, line 32 to col. 13, line 65.

Regarding Claim 20, Transue et al disclose receiving an election for an add or change payee for bill payment option at Fig. 3A, inputs 2 and 3 respectively and at col. 4, line 41 to col. 5, line 36.

As to Claim 22, Transue et al disclose receiving an election for a single bill payment option at Fig. 4, left hand side of figure and at col. 11, line 32 to col. 13, line 65.

Regarding Claim 23, Transue et al disclose receiving an election for a status, change or cancel bill payment option at Fig. 5, element 500 and col. 14, line 2, to col. 15, line 46.

Concerning Claim 30, Lawlor et al disclose receiving an ID number for the payee at col. 33, lines 12-19. It would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized an ID number as taught by Lawlor et al in the bill payment method disclosed by Transue et al because this would have avoided ambiguity and confusion in the identification of a particular payee. Further, Transue et al disclose the use of a payee ID number at col. 2, lines 22-36, thus suggesting the combination of the two references.

As to Claim 31, Transue et al disclose automatic identification of fields of information within the bill payment application at col. 6, line 63 to col. col. 7, line 22 and col. 16, lines 11-

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26. As other fields in their system are automatically identified, it would have been obvious to have so identified the payee according to an ID number because this would have provided seamless operation in the bill paying process.

Regarding Claim 33, Transue et al does not specifically disclose receiving a selection for the customer to enter information according to a payee list spoken for the customer and receiving a selection from the payee list. Lawlor et al disclose receiving a selection for the customer to enter information according to a payee list (col. 42, lines 60-62) and receiving a selection from the payee list (col. 42, line 60 to col. 43, line 68). See also the discussion of Claim 1 above. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included these features of Transue et al in the voice mode method of Transue et al because this would have provided an uniform and efficient way for customers to have selected payees.

Concerning Claims 34 see the discussion of Claims 1 and 31.

As to Claim 35, see the discussion of Claims 1 and 31 above.

As to Claim 36, see the discussion of Claim 1 and 35 and Transue et al further disclose automatically verifying a scheduled bill payment by receiving a confirmation of a payee at col. 11, lines 50-58.

As to Claim 44, Lawlor et al disclose assignment of a payment reference for a scheduled bill payment at col. 34, lines 1-4.

Concerning Claim 45, Lawlor et al disclose the use of the reference for service purposes for the user/customer. To provide such service, it would have been obvious to have provided such a reference to the customer in the method of Transue et al so that he or she would have a



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unique and simple means to identify the payment in discussions with bill payment service representatives.

Regarding Claims 46 and 47, Transue et al disclose automatically prompting for and selection of a hearing a list of bill payments at col. 14, lines 20-30 and Fig 15, element 504.

Concerning Claim 48, Transue et al disclose automatically speaking a list of bill payments at col. 14, lines 8-11.

As to Claim 51, Lawlor et al disclose combining of more than one bill in a payment at col. 11, lines 55-60.

Regarding Claim 55, Transue et al disclose automatically prompting for and receiving a selection of status, change or cancel option for bill payments at Figure 5 and col. 14, line 3 to col. 15, line 45; particularly col. 14, lines 3-5 and col. 14, lines 8, 31 and 64.

Concerning Claim 56, Transue et al disclose automatically prompting for (col. 14, lines 3-5) and receiving a selection of status of a future bill payment (col. 14, lines 20-23).

As to Claim 57, Transue et al disclose receiving a selection by the customer for the status of future bill payments at col. 14, lines 8-30.

Regarding Claim 58, Transue et al disclose the selection for the customer of status of all future bill payments at col. 11, lines 3-5 and 20-30.

Concerning Claim 59, Transue et al do not specifically disclose receiving a selection for the status of all open bill payments for the customer. Lawlor et al suggest such a selection at col. 14, lines 3-6 and col. 20, lines 44-53 in discussions of reconciliation. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a selection for display of all open bill payments because this would have made possible such reconciliation.

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For example, with status information for open bill payments and all bill payments, the customer would have been able to balance his or her checkbook; open bill payments represent "uncleared" checks, which information is essential to reconciliation.

Concerning Claim 60, Transue et al disclose automatically speaking a list of bill payments at col. 14, lines 8-11. It would have been obvious to have spoken the status of open bill payments because this would have facilitated the reconciliation suggested by Lawlor et al disclose and discussed regarding Claim 59.

As to Claims 61, Transue et al disclose receiving a selection by the customer for the status of future bill payments at col. 14, lines 8-30.

Regarding Claim 62 see the discussions of Claim 59 and 60 above.

As to Claim 63, Transue et al disclose change of all bill payments at col. 14, line 64 to col. 15, line 46.

Regarding Claim 64, Transue et al disclose receiving of a selection of single or recurring bill payments at Fig.4, element 402. Further, they teach change operations for bills processed by the system at col. 14, line 64 to col. 15, line 46.

Concerning Claims 65 and 66, see the discussion of Claim 64 above and Transue et al further teach automatic prompting of customers for bill payment change information at col. 14, lines 3-5.

As to Claims 67, see the discussion of Claim 64 above.

As to Claim 68, see the discussions of Claims 1 and 67 above.

As to Claim 69, Transue et al disclose cancellation of all bill payments at col. 14, 15, lines 31-63.

Regarding Claim 70, Transue et al disclose receiving of a selection of single or recurring bill payments at Fig. 4, element 402. Further, they teach cancellation operations for bills processed by the system at col. 14, lines 31-63.

Concerning Claims 71 and 72, see the discussion of Claims 70 above and Transue et al further teach automatic prompting of customers for bill payment cancellation information at col. 14, lines 3-5.

As to Claim 73, see the discussion of Claim 70 above.

Regarding Claim 74, Transue et al disclose automatic handing off of the customer to a customer service representative at col. 15, lines 47-62 and Fig. 1, "To Speak with a Customer Service Representative" element.

As to Claim 75, it is essentially the system form of Claim 1 discussed above, less the non-optional aspect of handing off, and is rejected in a like manner

As to Claim 76, Lawlor et al disclose a bill payment application running on a server at Figure 1, element 52, and col. 19, lines 37-53.

As to Claim 77, Transue et al disclose a retail system application communicating with a bill payment application at col. 15, line 63 to col. 16, line 10.

Concerning Claims 78 and 79, Transue et al disclose an input device as a telephone at col. 4, lines 2-40.

As to new Claim 82, it recites the handing off to a CSR for recurring or add/change options which are addressed in the rejection of Claim 1 with the application of the newly cited Porter reference.

As to Claim 83, it recites payee list variants addressed in the Response to Arguments.

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As to Claim 84, see the discussions of Claims 1, 82 and 83.

***Response to Arguments***

Applicant's arguments filed October 7, 2002 have been fully considered but they are not persuasive.

Initially, the Examiner notes that the Assignee of the Porter reference and the entity apparently making the claimed instant invention are related in some fashion to Citibank. See at least Applicants' drawing Figures 2-7 and 9 which refer to "Citiphone" and "Citicard". See also the Business Wire reference which describes a Citibank bill payment service using voice response technology similar to Applicants' invention.

At pages four through ten of Applicants' Remarks, an exhaustive description of the prior art of record is set forth. At mid- page of page ten, Applicants' substantive arguments regarding the features begins. First, Applicants discuss the non-optional handing off of a customer to a customer services representative for particular bill payment functions is set forth. The application of the new Porter et al reference above obviates this argument.

Secondly, Applicants set forth arguments regarding common and customer-specific payee lists. As noted above and in the prior office action, Lawlor discloses common payees lists at Col. 10, lines 44-53, "The list of payees the user selects can be anyone..." and customer-specific payee lists at Col. 33, lines 3-22. Applicants assert that these features are not present in the cited prior art of record, but fails to show how this feature of their invention distinguishes over the passages cited. At the first full paragraph of page 12, Applicants cite Lawlor's Background of

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the Invention at Col. 5, lines 15-19 arguing pre-specified accounts which are *not* taught as part of Lawlor's invention. The Examiner restates the above citations at Cols. 10 and 33.

For these reasons the rejections are maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

crk

December 16, 2002



**HANI M. KAZIMI  
PRIMARY EXAMINER**